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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,549	01/21/2004	Marion F. Wyatt	T0462.10V	2837

7590 09/13/2005

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EXAMINER
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LE, HOA VAN

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/761,549

Applicant(s)

WYATT ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 10 March 2005 and 23 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 11-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 11-16 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>21 January 2004</u> . | 6) <input type="checkbox"/> Other: _____  |

This is in response to Papers Dated 10 March and 23 May 2005.

- I. Applicants elect the invention of Group I, process claims 1-10 without traverse being acknowledged.
- II. Applicants state on the record that they will file a terminal disclaimer over the related claims in the patent No. 6,162,593.
- III. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).  
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).  
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-8 of U.S. Patent No. 6,162,593. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

The new added language with respect to “such that exposed area of the photosensitive resin composition are crosslinked” and/or “of the crosslinked area” is the inherent property of the photosensitive material after it is exposed.

Applicants may or should show convincing evidence to the contrary that the instant claims are related to a different and distinct photosensitive material than that in the applied claims in the patent. Therefore or accordingly, the newly added language should and must provide an added different and distinct property in accordance with *In re Schreiber*, 44 USPQ2d 1429.

The language “comprises” in the instant claims includes one or more co-solvents in the instant claim 2 such as benzyl alcohol, steps in the instant claims 4 and 5, azeotropic mixture in the instant claim 6, an amount in the instant claims 9 and 10.

The language “comprises” in the applied claim 3 includes tetrahydrofurfuryl alcohol and terpene in patent at col.5:52 and 58 as those in claims 3, 7 and 8. Applicants may make or urge to the contrary on record that they have no intension to include any of a co-solvent or any chemical ingredient from any disclosure embodiment to any claim.

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IV. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 and 9-10 are rejected under 35 U.S.C. 102(b)) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schlosser et al (5,312,719).

(A) Schlosser et al disclose and teach a process for making and obtaining a flexographic printing plate comprising the steps of obtaining a negative photosensitive material layer on a support, negative crosslinked pattern exposing, washing away the unexposed soft portions with a solvent or solvent mixture containing two isopropyl substituents (such as R<sup>1</sup> and R<sup>2</sup>) and two hydrogen bonding atoms (such as R<sup>3</sup> and R<sup>4</sup>) on the general formula (I) as the main solvent in up to 100 wt%, drying. Please see col.2:31-46, 3:31-48 and 5:27-51.

Since Schlosser et al reasonably disclose and teach the above claimed embodiments, they are found to be anticipated by Schlosser et al.

(B) In an alternative, Schlosser et al broadly disclose, teach and suggest the above claimed embodiments but fail to demonstrate or reduce to practice with the two isopropyl substituents (such as  $R^1$  and  $R^2$ ) and two hydrogen-bonding atoms (such as  $R^3$  and  $R^4$ ) on the general formula (I). The above claims are at least found to be rendered prima facie obvious by Schlosser et al since Schlosser et al broadly disclose, teach and suggest that such two isopropyl substituents (such as  $R^1$  and  $R^2$ ) and two hydrogen bonding atoms (such as  $R^3$  and  $R^4$ ) on the general formula (I) would be able to sufficiently develop and negative exposed flexographic printing plate precursors as those demonstrate or reduction to practice for about the same reasonable expectation of obtaining excellent flexographic on at least col.5:67-68.

V. Claims 3-5 and 8 are rejected under 35 U.S.C. 102(b)) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schlosser et al (5,312,719) considered in view of Worns et al (4,847,182).

Schlosser et al disclose, teach and suggest a process for making and obtaining a flexographic printing plate comprising the steps of obtaining a negative photosensitive material layer on a support, negative crosslinked pattern exposing,

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washing way the unexposed soft portions with a solvent or solvent mixture containing two isopropyl substituents (such as  $R^1$  and  $R^2$ ) and two hydrogen bonding atoms (such as  $R^3$  and  $R^4$ ) on the general formula (I) as the main solvent in up to 100 wt%, drying. Please see col.2:31-46, 3:31-48 and 5:27-51.

Schlosser et al do not specify a name of terpene co-solvent in claims 3 and 8, a reclaiming solvent in claim 4, distillation in claim 5 and terpene in claim 8.

Worns et al at col.3:2-5 is cited to show the known use of terpenes as solvents for a sufficiently washing out soft portions an exposed flexographic printing plate precursors and the known recovery of a solvent or solvent mixture by distillation at col.5:48-53 for reusing solvents.

Since the above references are all related to processes of making and obtaining negative flexographic printing plate, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the known uses of terpene solvent for a reasonable expectation of sufficiently washing out soft portions of an exposed negative flexographic printing plate precursors and reclaiming solvent by distillation solvent-water mixture in order to reuse solvents as disclosed, taught and suggested in Worns et al.

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VI. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332. The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
06 September 2005

HOA VAN LE  
PRIMARY EXAMINER  
